

**REMARKS/ARGUMENTS**

Claims 1, 4, 6-12, 15-21, 24, 26, 27, 30, and 31 are pending in the present application. Claims 1, 4, 6, 12, 15, 18, 24, 26, 27, and 30 have been amended. Claims 2, 3, 5, 13, 14, 22, 23, 25, 28, and 29 have been canceled. No new matter has been added. Reconsideration of the rejected claims is respectfully requested.

**I. Examiner Interview**

A telephone interview was conducted with Examiner Whipple on July 3, 2008, at 10:00AM PDT. Applicants' representatives Jason Lohr and the undersigned attorney represented the Applicants in the interview. Applicants wish to thank the Examiner for his time and careful consideration of the matter presented.

During the interview, differences between the subject matter of Applicants' claims and the cited art were discussed. Further, the Examiner's Official Notice taken on page 5 of the Office Action was discussed in regard to claim 5. Subsequent to the discussion, the Examiner indicated that the Official Notice did not address the features of claim 5 and suggested amending claim 1 to include limitations such as those discussed with respect to claim 5. Applicants appreciate the Examiner's helpful suggestions, and have amended the claims in accordance with the Examiner's suggestions. Thus, Applicants believe that the claims as amended are allowable over the cited art.

**II. Rejection under 35 U.S.C. § 102(e)**

Claims 1-4, 6, 8, 10-11, 14-15, 18, 22-24, and 26 are rejected under 35 U.S.C. § 102(e) as being anticipated by *Aoki* (U.S. Patent No. 7,194,484). Applicants respectfully submit that *Aoki* does not disclose each and every element of these claims.

For example, claim 1, as amended, recites:

A method for managing failure messages for email messages, the method comprising:

receiving a failure message from an Internet service provider (ISP) when the ISP is unable to deliver an email message to an email address associated with the ISP;

determining, for the failure message, a failure type based on a determined rule for classifying the failure message; and  
performing an action in response to receiving the failure message,  
wherein **the action is determined at least in part based upon the determined failure type and the ISP associated with the email address.**

(emphasis added).

*Aoki* discloses a process for updating electronic information by inspecting "inbound email messages for information indicative of the status of [e]mail addresses for possible updates to the addresses." (*Aoki*, col. 4, lines 44-47.) Then, *Aoki* performs an update anytime updated address information is present. (*Aoki*, col. 4, lines 47-50 and 58-62.) For example, if an email message is undeliverable, then an address book will be updated to reflect the fact that the undeliverable address is no longer functional. (*Aoki*, col. 4, lines 58-62.)

*Aoki* does not perform an action or update, "wherein the action is determined at least in part **based upon** the determined **failure type** and **the ISP** associated with the email address," as recited in claim 1. Because *Aoki* discloses updating electronic information based on information from **any** failure message, *Aoki* necessarily does not disclose updating based upon **the determined failure type**. *Aoki* does not need to distinguish between failure types because it examines all failures to determine if the error message contains information that would allow an update of an address book. (*Aoki*, col. 4, lines 44-57.)

Furthermore, *Aoki* does not update addresses or otherwise take action based upon **the ISP associated with the email address**. Instead, as best understood, *Aoki* takes action based on failures associated with individual **addresses** regardless of the ISP associated with the address. (*Aoki*, col. 5, lines 11-18.) Thus, there is no disclosure for *Aoki* to update an address based on **the ISP associated with the email address**. Therefore, there is no disclosure for *Aoki* to update an address based on a failure type **and** the ISP associated with the email address.

For at least these reasons, claim 1 and the claims dependent therefrom cannot be anticipated by *Aoki*. The other pending claims, as amended, recite limitations that similarly are not disclosed by *Aoki*, for reasons including those discussed above, such that those claims also cannot be anticipated.

**III. Rejection under 35 U.S.C. § 103(a)**

Claims 5, 7, 12-13, 16-17, 19-21, 25, and 27-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Aoki* as applied to claims 1, 3, 18, and 23, and in view of what was well known in the art at the time of the invention. Applicants respectfully submit that *Aoki* does not teach or suggest each element of these claims.

For example, claim 12 as amended recites:

A method for categorizing failure messages from a plurality of Internet service providers (ISPs), the method comprising:  
receiving a failure message corresponding to an email address associated with a corresponding ISP of the plurality of ISPs when the corresponding ISP is unable to deliver an email message to the email address;  
**determining a set of rules that is associated with the corresponding ISP for classifying the failure message;**  
determining a failure type of the failure message based on a determined rule of the set of rules for the corresponding ISP; and  
performing an action in response to receiving the failure message,  
**wherein the action is determined at least in part based upon the determined failure type and the corresponding ISP associated with the email address.**

As discussed above, *Aoki* does not disclose an action that "is determined at least in part based upon the determined failure type and the corresponding ISP associated with the email address." In addition, these elements are not suggested by *Aoki* because *Aoki* does not need to discern between failure types and corresponding ISPs to update address information. *Aoki* needs only to look at any failure message to see if it contains any information that can be used to update a sender's address book, so the failure type is unimportant because every failure message is examined. Also, *Aoki* does not suggest determining an action based on the corresponding ISP associated with the email address since every failure message is reviewed regardless of the ISP. Thus, *Aoki* does not teach or suggest these elements of claim 12.

Furthermore, on page 5, the Office Action, concedes that *Aoki* does not disclose that "different ISPs are associated with different invalidation rules." Thus, *Aoki* does not disclose "determining a set of rules that is **associated with the corresponding ISP** for

classifying the failure message." However, the Office Action takes Official Notice that "different ISPs will choose from among different invalidation rules."

Applicants traverse the Official Notice because claim 12 does not claim that "ISPs will choose among different invalidation rules" as the Official Notice asserts. Instead, claim 12, as amended, recites a method that **determines** "a set of rules that is associated with the **corresponding ISP for classifying the failure message.**" Thus, the Official Notice does not accurately address the claim language, and applicants respectfully request reconsideration of claim 12.

For at least these reasons, claim 12 and the claims dependent therefrom cannot be anticipated by *Aoki*. The other pending claims, as amended, recite limitations that similarly are not disclosed or suggested by *Aoki*, for reasons including those discussed above, such that those claims also cannot be anticipated.

#### **IV. Amendments to the Claims**

Unless otherwise specified, amendments to the claims are made for purposes of clarity, and are not intended to alter the scope of the claims or limit any equivalents thereof. The amendments are supported by the specification and do not add new matter.

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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